

Remarks

Reconsideration of this application is respectfully requested in view of the foregoing amendments and the following remarks.

The Examiner has rejected claims 28-36 and 38-40 under 35 U.S.C. §112, second paragraph. Claims 28, 29, and 30 have been amended to remove the word “forming.” It is respectfully submitted that the claims as written now are written to overcome the above identified rejection.

In addition, the Examiner has rejected claims 38-41 under 35 U.S.C. 112 second paragraph. In this case, the Examiner states that the reflection ink layer cannot form a face opposite the open face. It is respectfully submitted that the reflection ink layer has a face which is on the opposite side of the open face which is adhered to the substrate. Therefore, these claims have been amended accordingly.

The Examiner has rejected claims 28-30, 32-37 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,172,942 to *Berg* in view of U.S. Patent No. 3,420,597 to *Nellessen et al.* Claim 31 has been rejected under 35 U.S.C. §103(a) as being unpatentable over *Berg* in view of *Nellessen et al.*, as applied to claim 30 above, and further in view of Applicant’s Admitted Prior Art (AAPA).

The Applicant's attorney William Collard, hereby thanks Examiner Zimmerman for the telephone interview on July 22, 2009. The substance of the interview is that an agreement was reached with Examiner Zimmerman that if the applicant added additional elements to the remaining independent claims, these claims would be allowable over the existing rejection, pending an additional search.

The language to be added and as discussed in the interview is as follows:

"wherein said face on the opposite side of said open face, is a correct side of said transfer adhesive to accord with a motif desired."

The above passage was placed in each of the independent claims. Support for this passage is found in the specification on page 7 lines 11-19, on page 8 lines 19-24, page 13 line 19, page 16, line 5, and on page 17, line 26.

In all of claims 28, 29, 30, 37 and 42, the open face is recited as being formed by the removal of the adhesive repellent base medium.

In the interview, the applicant's attorney discussed with Examiner Zimmerman the meaning of the phrase "correct side of the transfer adhesive with a motif desired." Essentially,

the applicant's attorney and Examiner Zimmerman agreed that the above term indicates that there is only one correct side and that the above phrase describes a motif of a particular orientation.

It is respectfully submitted that the above added passage renders the remaining independent claims new and non obvious because of the many differences between the present invention as claimed in independent claims 28, 29, 30, 37 and 42 and the combination of Berg with the other cited references.

The differences are as follows:

1) Berg teaches a process which has an entirely different order, this was admitted by the Examiner on page 8 of the previous office action;

2) Berg fails to teach that the reflection ink is applied directly to the transfer adhesive (see page 7 of the latest office action)

3) Berg requires the application of an adhesive layer after the transparent beads have been placed on the carrier coating.

4) Berg requires the application of a carrier coating (See FIG. 1) because the carrier base receives the beads without an adhesive layer as claimed in claims 28, 29, 30, 37 and 42;

5) Berg also requires a heat barrier film, (element 17 in FIG. 1) which is not required by the present invention as claimed in independent claims 28, 29, 30, 37, and 46;

6) The combination of Berg with the other references does not disclose that the face on the opposite side of the open face is a correct side of said transfer adhesive to accord with a motif desired, (instead Berg discloses that the adhesive layer of Berg is applied such that when it is applied it forms a mirror image on the surface).

Regarding difference recited in paragraph number 4 above, this carrier coating has to be provided because the beads and pigment have to be placed onto the carrier base because otherwise they would not remain on the carrier base. With the present invention, a carrier base does not need to be provided, rather the adhesive layer acts as a base for receiving the reflective particles, with the adhesive layer being applied directly to the base. Therefore, the present invention as claimed in independent claims 28, 29, 30, 37 and 42 provides the unexpected result that the image can be placed on the substrate with the correct side up, unlike the above references including Berg, and also be made in a simpler manner with fewer layers than the teaching of Berg.

With this style application, because the correct side is up, the motif that is applied to a carrier base is the same motif that is viewed after the application to a substrate. In contrast, with Berg, once the transfer art is applied to the substrate, the motif is the exact opposite or mirror image of the image formed on the carrier base.

Therefore, because the present invention as claimed in claims 28, 29, 30, 37, and 42 provides both new and unexpected results, it is respectfully submitted that these claims are patentable over the above cited rejection, and documents.

In light of the above differences with Berg, it is respectfully submitted that Berg in combination with Nellesen or in combination with any of the above listed documents cannot be used to find the present invention as claimed in claims 28, 29, 30, 37 or 42 or in any of the dependent claims obvious.

It is respectfully submitted that the result of the present invention results in a new result in that once the transfer adhesive is applied to the substrate, the face on the opposite side of the open face (which is the face initially attached to the carrier base) forms the correct side for imaging purposes, which allows a printer or applicator to apply artwork with the correct side facing out on a substrate such as an article of clothing. This feature allows the producer of the artwork to make the artwork as it would be seen by the user and as applied to a substrate, and not

be forced to make in a mirror image. It also allows for fewer layers because the present invention by virtue of its new and novel order for steps results in fewer layers such as reducing out the carrier coating and the heat barrier film. With the present invention as claimed in claims 28, 29, 30, 37, and 42, a carrier coating is not required because the ink and the beads are instead applied to the adhesive which is on the base medium.

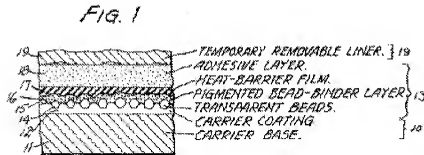
This opposite process disclosed in *Berg* requires the application of artwork which forms a mirror image of the artwork to be viewed, because the artwork is applied face down.

Instead, with the present invention as claimed in claims 28, 29, 30, 37, and 42, the artwork is applied in a reverse order such that the adhesive repellent base medium can be pulled away to allow an open face to be formed and thereby allowing the transfer adhesive to be applied directly to the substrate.

Thus, as provided in the previous response, one of the benefits of the invention as claimed in claims 28, 29, and 30 is that the reflection transfer can be applied to the substrate such that it is applied in a face up manner such that it is not applied as a mirror image. Thus, the exact image that appears on the reflection transfer also appears on the substrate. New claim 42 is similar to claim 28, however new claim 46, requires that all of the steps be performed in order of their listing.

In addition, Berg does not even support the Examiner's premise that the steps of the claims are disclosed but in reverse order. For example while the Examiner has indicated at the top of page 4 in his office action that the step of "initially providing an adhesive repellent base medium" is disclosed in Berg, it is respectfully submitted that this feature is not shown in Berg.

For example, reference numeral 19 in Berg is not an adhesive repellent base medium but rather a temporary removable liner as disclosed in FIG. 1 below:



Instead element 11 of Berg indicates that it is a "Carrier Base" which is completely different from a "temporary removable liner 19". Therefore, it is respectfully submitted that based upon the above amendments the reference to Berg should no longer apply.

The Examiner even references the paragraph in column 7 lines 9-21 which describes a process which is entirely different from the present invention and results in a mirror, or reverse image being displayed on the substrate because the side attached to the base medium is being displayed in Berg rather than being adhered to the substrate as claimed in independent claims 28, 29, 30, 37 and 42. Since the features of the above identified invention as claimed in claims 28, 29, 30, 37 and 42 are not shown in the above references, it is respectfully submitted that claims 28, 29 30, 37, and 42 are patentable over the above cited references. In addition, it is respectfully submitted that because the remaining dependent claims 31-36, 38-41 depend from any one of claims 28, 29, 30, and 37, it is respectfully submitted that these claims are patentable as well.

The Commissioner is hereby authorized to charge Collard & Roe, P.C.'s deposit account 03-2468 for one additional independent claim and to charge this deposit account for any other necessary fee or to credit the account as well. It is respectfully submitted that the remaining claims are patentable.



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Therefore, early allowance of the remaining claims is respectfully requested.

Respectfully Submitted,

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